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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,462	02/25/2000	Markus Lautenbacher	SEIM0023U/US	7313

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/513,462	LAUTENBACHER, MARKUS
Examiner	Art Unit	
Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 August 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

Response to Amendment

This is in response to an amendment file on August 19th, 2003. Claims 1, 5 and 11 have been amended, claims 2 has been canceled, and claims 15 have been added. Claims 1, 3-15 are pending in the letter.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern et al (U.S. Patent No. 6,282,711) in view of Ahmad (U.S. Patent No. 5,925,127).

3. As per claims 1, Halpern et al teach a method of using software products that are offered via a network (*see abstract, fig 1*) comprising inquiring about a software (*software components*) product from an offer server (*remote server, 102*) by a user via a terminal device (*client system 101*) downloading (*downloading*) the software product from the offer server via the network onto the terminal device in response to the inquiry of the user (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*) activating (*installing*) a software component (*subset*) of the software product; starting a communication by way of the software component with a usage processing server regarding a usage of the software product in response to a call of the software product in the

terminal device of the user (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*). Halpern et al fail to teach an inventive concept of providing, by the software component in a framework of the communication, data to the usage processing server; and checking the data, by the usage processing server, and then making a determination selected from the group consisting of: whether usage of the software product is approved with respect to the inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts. However Ahamad teach an inventive concept of providing, by the software component in a framework of the communication, data to the usage processing server; and checking the data, by the usage processing server, and then making a determination selected from the group consisting of: whether usage of the software product is approved with respect to the inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts (*see fig 3, column 9 line 15-12 line 10*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Halpern et al's inventive concept to include Ahamad's inventive concept of providing, by the software component in a framework of the communication, data to the usage processing server; and checking the data, by the usage processing server, and then making a determination selected from the group consisting of: whether usage of the software product is approved with respect to the inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts because this would have facilitate software application provider to monitor the usage of their software application usage thereby increase the revenue of the provider.

4. As per claim 3, Halpern et al teach a method further comprising operating the usage processing and the offer server by a network provider (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

5. As per claims 4, Halpern et al teach a method further comprising using a web server for a server selected from the group consisting of the offer server and the usage processing server (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

6. As per claims 5, Halpern et al teach a usage processing server comprising: a usage processing module for processing a software product downloaded from a network; and wherein usage processing data required to perform usage processing are delivered to the usage processing server (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*). Halpern et al fail to teach an inventive concept wherein the usage processing server is contacted by the software product after the software product has been downloaded into a terminal device of a user and has been activated. However, Ahmad teach an inventive concept wherein the usage processing server is contacted by the software product after the software product has been downloaded into a terminal device of a user and has been activated (*see fig 3, column 9 line 15-12 line 10*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Halpern et al's inventive concept to include Ahmad's inventive concept wherein the usage processing server is contacted by the software product after the software product has been downloaded into a terminal device of a user and has been activated because this would have facilitate software

application provider to monitor the usage of their software application usage thereby increase the revenue of the provider.

7. As per claims 6, Halpern et al teach a usage processing server further comprising: a data store in which a software product identification of the software product and type of usage processing data that prescribe a type of usage processing of the software product are stored by the usage processing module, and wherein the usage processing module registers the software product (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

8. As per claims 7, Halpern et al teach a usage processing server wherein: the usage processing data required comprises a software product identification of the software product and a user identification (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

9. As per claims 8, Halpern et al teach a usage processing server wherein: the usage processing comprises performing an access control (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

10. As per claims 9, Halpern et al teach a usage processing server wherein: the usage processing comprises performing a usage charging of the software product on user accounts and provider accounts (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

11. As per claims 10, Halpern et al teach a usage processing server according to claim 5, wherein the usage processing module keeps statistics about usage contacts that have taken place and about results of a processing of the usage contacts (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

12. As per claims 11, Halpern et al teach a software product wherein the software product can be downloaded into a terminal device by a user via a network in response to an inquiry from the user (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*). Hapern et al's fail to teach an inventive concept of a software component that is activated when called by the software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to the usage processing server in the framework of the communication. However Ahmad teach a software component that is activated when called by the software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to the usage processing server in the framework of the communication (*see fig 3, column 9 line15-12 line 10*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Halpern et al's inventive concept to include Ahamad's inventive concept a software component that is activated when called by the software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to the usage processing server in the framework of the communication because this would have facilitate software application

provider to monitor the usage of their software application usage thereby increase the revenue of the provider.

13. As per claims 12, Halpern et al teach a software product wherein the usage processing data comprises: software product provider data; and software product identification; and wherein the usage processing data is dynamically determined user data (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

14. As per claims 13, Halpern et al teach a software product wherein the software component interacts with the user to produce the dynamically determined user data (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

15. As per claims 14, 15, Halpern et al teach a method for the generation of a software product that is offered via a network (*see abstract, fig 1*), comprising the steps of installing a software component in source code of the software product of a software manufacturer by using a software development kit provided by a usage processing provider (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*). Hapern et al fail to teach an inventive concept of activating the software component when called by the software product; starting a communication by the software component with a usage processing server after the step of activating the software component; sending, by the software component, usage processing data that are required for performing usage processing to the usage processing server in the framework of the communication. However, Ahamad teaches a inventive concept of activating the software

component when called by the software product; starting a communication by the software component with a usage processing server after the step of activating the software component; sending, by the software component, usage processing data that are required for performing usage processing to the usage processing server in the framework of the communication (*see fig 3, column 9 line 15-12 line 10*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Halpern et al's inventive concept to include Ahamad's inventive concept of activating the software component when called by the software product; starting a communication by the software component with a usage processing server after the step of activating the software component; sending, by the software component, usage processing data that are required for performing usage processing to the usage processing server in the framework of the communication because this would have facilitate software application provider to monitor the usage of their software application usage thereby increase the revenue of the provider.

Response to Arguments

16. Applicant's arguments filed August 19th, 2003 have been fully considered but they are not persuasive.

a. Applicant amended claims 1, 5 and 11 and argues that the prior arts taken alone or in combination fail to teach an inventive concept wherein the usage processing server is operated by a network provider. Examiner respectfully disagrees with applicant characterization of Halpern et al and Ahmad's inventive concept. Ahmad teach an

inventive concept for a program software module rental method and system that allow software applications to be rented on a pat-per-use basis from a rental service provider while allowing the rental service provider to monitor use of the rented software application. This is a clear indication that the usage processing server is operated by a network (service) provider. Applicant further argues that there is no motivation to combine the reference. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the inventive concepts are similar in nature and the combined inventive concept would be operational.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

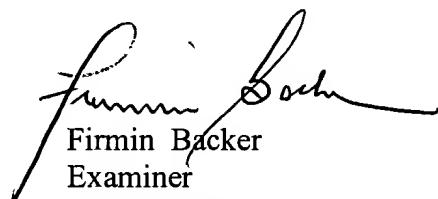
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

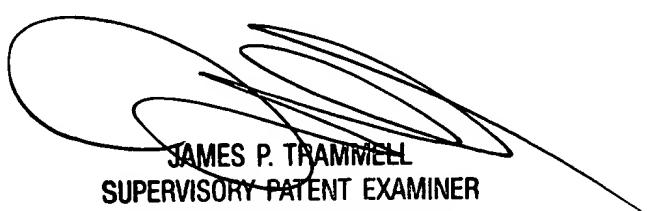
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Firmin Backer
Examiner
Art Unit 3621

September 17, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600